

Claims 7 and 15 were rejected under 35 USC § 112, first paragraph, as lacking adequate enabling support in the disclosure. In response, Applicant submits that methods for developing only portions of photographic frames were well known in the art at the time the present invention was made. Therefore, enablement does not require that the specification teach such methods. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 94 (Fed. Cir. 1986), "a patent need not teach, and preferably omits, what is well known in the art (emphasis added)."

Claims 9-16 were rejected under 35 USC § 112, second paragraph, as being indefinite. The Examiner indicated that line 2 of claim 9 created uncertainty. In response, Applicant has replaced claim 9 by claim 17, which, hopefully, will be acceptable to the Examiner. What Applicant intends to cover is the use of the film according to claim 1 in a camera to take a photograph, which is developed. Applicant submits that claim 17 conveys this intent in a clear and definite manner. An early notice to that effect is earnestly solicited or, failing that, a suggestion by the Examiner how claim 17 might be favorably amended.

Claims 1-3, 6, 8-11, 14 and 16 were rejected under 35 USC § 102(b) as being anticipated by either Ames or Guez.

Claims 4, 5, 12 and 13 were rejected under 35 USC § 102(b) as being anticipated by either Ames or Guez or, in the alternative, under 35 USC § 103(a) as being obvious over Ames or Guez in view of Jones.

In response, to both prior art rejections, Applicant points out that all of the instant claims require "A sealed package of photographic film." This means, for example, that photographic film having the elements of claim 1, namely a plurality of exposable photographic frames, each comprising an unexposed portion and an exposed portion, has been placed into a package and sealed.

Respectfully, Applicant does not see—and the Examiner has not indicated—where in either Ames or Guez, there is any teaching of a sealed package of film having the claimed characteristics. In the absence of such teaching, neither reference can anticipate any of the present claims. And, in the absence of such teaching and a secondary reference that would motivate a person of ordinary skill in the art to package the films of Ames or Guez, neither reference can render obvious any of the present claims.

The Examiner's position appears to be that the prior art reveals processes for preparing a composite photograph of two images by exposing one portion of the film to a first image and later exposing the remaining portion of the film to a second

image. Even if true, this is not what Applicant claims.

Applicant claims a package of film, wherein the film in the package is already exposed on a portion of each of the photographic frames. The package of film can be sold to the masses, who can use the film in their cameras to photograph on the unexposed portion of the film and, thereby, make a composite photograph. The invention, thus, overcomes the need in the art for specialized devices and expertise in order to achieve this goal. The invention is simple, widely useful, and of practical importance.

Addressing the cited references in greater detail, Applicant points out first that the substrate of Ames is expressly not a film, but, rather, is a "sensitized positive paper." See, for example, column 1, lines 3-5. Accordingly, Ames could not, in any case, anticipate "A sealed package of film," as presently claimed.

Moreover, the invention in Ames actually relates to a complex apparatus, whereby through the successive use of two cameras labeled C' and C, respectively, the background design and the central image are photographed onto the paper in successive steps. Most importantly, the paper proceeds directly from C' to C. Accordingly, there is no teaching of "A sealed package of film," as presently claimed. Moreover, there is no need to package the partially exposed film. Indeed, packaging

the partially exposed film only makes sense where, as here, the film is intended to be sold partially exposed, with the composite photograph to be completed by the user.

In short, Applicant sees nothing in Ames that amounts to an anticipation.

On the issue of obviousness, Ames was combined with Jones. However, the obviousness rejection was dependent upon Ames constituting an anticipation of claim 1, which it does not. Moreover, Jones was cited to show that it was known to use masks to create decorative borders. However, even if the Examiner's assessment of Jones were accurate, the combination of Ames and Jones still would not suggest the present invention. First, nothing in Jones overcomes the prejudice established by Ames of using paper instead of films. Second, nothing in Jones overcomes the prejudice established by Ames of preparing the composite photograph in a series of directly linked photograph actions, i.e., without intermediate packaging of partially exposed film. Accordingly, nothing in the combination of Ames and Jones would lead a person of ordinary skill in the art to package a partially exposed photographic film, as presently claimed.

Regarding Guez, he also does not describe "A sealed package of film," as presently claimed, i.e., wherein the package that is sealed contains partially exposed

photographic film. Accordingly, again, Applicant does not see anything in Guez that amounts to anticipation.

Guez does teach pre-exposure of a portion of film, and then later exposure of the remaining portion. However, this is effected through a complex scheme, which requires that the film be rewound carefully, and carefully repositioned after all of the partial exposures are made. See column 10, line 40 ff. Moreover, there is no teaching or suggestion that prior to such rewinding, the film is packaged. So, again, Guez does not anticipate the present claims.

On the issue of obviousness, Guez was combined with Jones. However, the obviousness rejection was, again, dependent upon Guez constituting an anticipation of claim 1, which it does not. Moreover, Jones was cited to show that it was known to use masks to create decorative borders. However, even if the Examiner's assessment of Jones were accurate, the combination of Guez and Jones still would not suggest the present invention. As was the case with the combination of Ames and Jones, nothing in Jones overcomes the prejudice established by Guez of preparing the composite photograph without intermediate packaging of partially exposed film. Accordingly, nothing in the combination of Guez and Jones would lead a person of ordinary skill in the art to package a partially exposed photographic film, as presently claimed.

ROBERT TRICK
USSN 08/100,019

Applicant believes that the foregoing adequately deals with all outstanding objections and rejections.

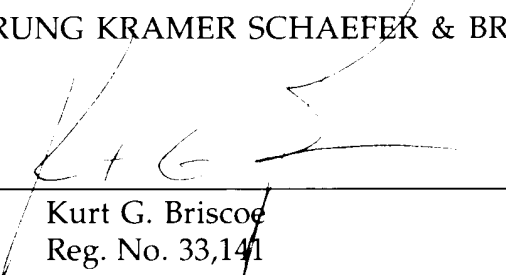
Applicant further believes that this application is now in condition for immediate allowance. However, should any issues of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (914) 332-1700 so that the issues might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

SPRUNG KRAMER SCHAEFER & BRISCOE

By


Kurt G. Briscoe
Reg. No. 33,141

660 White Plains Road
Fourth Floor
Tarrytown, New York 10591-5144
(914) 332-1700

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date indicated below:

Date June 22, 1998

By


Kurt G. Briscoe